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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/757,131	01/14/2004	Mototaka Iwata	MIZ46.CON	3815
6980	7590	11/03/2004	EXAMINER	
TROUTMAN SANDERS LLP BANK OF AMERICA PLAZA, SUITE 5200 600 PEACHTREE STREET, NE ATLANTA, GA 30308-2216			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/757,131

Applicant(s)

OSAKA

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. The changes to the specification are agreed with.

### ***Information Disclosure Statement***

2. The argument with respect to Japanese document 5-27951 is agreed with and the reference has been considered as indicated on the initialed IDS sent in the previous Office Action dated 16 June 2004.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (5,330,187) in view of Kosmatka (GB 2,331,249).

Schmidt discloses a single projected wall portion offset from a face portion and extending upward from a sole portion and having a length along an axis toe to heel that

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is less than a length of a cavity portion along an axis in the form of slots ending the length of the wall and the surface with the reference number 81 located in figure 17 is a single wall (Fig. 17), wall portion rising along a face portion toward a top edge portion (Fig. 2), and a wall portion being trapezoidal in the form of the middle bottom wall (Fig. 17).

Schmidt lacks a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove, a thickness of a ball hitting portion being made greater than a thickness of a toe side portion of a face portion located between a toe portion of a head portion and a ball hitting portion and greater than a thickness of a heel side portion of a face portion located between a heel portion of a head portion and a ball hitting portion, a thickness of a first region as defined by the claims being smaller than a thickness of a second region defined by the claims, and a thickness of a third region as defined by the claims being smaller than a thickness of a fourth region as defined by the claims.

Kosmatka discloses a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove in the form of a head being able to hit a

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ball low on a face (Fig. 1D), a thickness of a ball hitting portion being made greater than a thickness of a toe side portion of a face portion located between a toe portion of a head portion and a ball hitting portion and greater than a thickness of a heel side portion of a face portion located between a heel portion of a head portion and a ball hitting portion (Figs. 1B, 1C, 1E), and a thickness of a first region as defined by the claims being smaller than a thickness of a second region defined by the claims, and a thickness of a third region as defined by the claims being smaller than a thickness of a fourth region as defined by the claims (Fig. 1B) in order to design a rear face assigning thickness to each area of the face according to a magnitude of internal stress expected to be experienced by each area when a force due to striking a ball by a club front face is experienced and assigning a greater thickness in areas where the stress is greater and lesser thickness where the stress is lesser (Abstract). In view of the publication of Kosmatka it would have been obvious to modify the head of Schmidt to have a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove, a thickness of a ball hitting portion being made greater than a thickness of a toe side portion of a face portion located between a toe portion of a head portion and a ball hitting portion and greater than a thickness of a heel side portion of a face portion located between a heel portion of a head portion and a ball hitting portion, a thickness of a first region as defined by the claims being smaller than a thickness of a

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second region defined by the claims, and a thickness of a third region as defined by the claims being smaller than a thickness of a fourth region as defined by the claims in order to design a rear face assigning thickness to each area of the face according to a magnitude of internal stress expected to be experienced by each area when a force due to striking a ball by a club front face is experienced and assigning a greater thickness in areas where the stress is greater and lesser thickness where the stress is lesser.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (5,330,187) in view of Kosmatka (2,331,249) as applied to claims 18-21 above, and further in view of Official Notice.

The examiner takes Official Notice that it is well known to form golf club heads by forging.

### ***Response to Arguments***

6. The argument that the reference of Schmidt is improper since in figure 17 it is not disclosed "only a single projected wall portion that extends upward from the sole" is disagreed with. The claims do not contain the word "only" but a single wall. Clearly in figure 17 there appears at least three single walls extending upward from the sole.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 31 October 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**